

FROM Starkweather & Associates

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App. No. 10/743,930
Attorney Docket 3016.2.3 NP

Amendments to the Drawings

None

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Remarks

Applicant appreciates the teleconference of May 5, 2005, with the Examiner of record. During the teleconference, the claims were discussed in light of the prior art and new claim language was explored. It was agreed to more specifically describe the structural relationship of the plurality channels to the fabric. No agreement was reached regarding exact claim language to be used.

Applicant thanks the Examiner for the Written Office Action. In particular, Applicant thanks the Examiner for the additional art referenced. Also, Applicant thanks the Examiner for noting the typographical errors in Claims 10 and 11.

With regards the substantive portion of the Written Office Action, Claims 10 – 27 were rejected. In particular, Claims 10 and 11 were objected to for typographical errors. Further, Claims 10 – 14, 17 – 18, 21 – 22, and 25 – 27 were rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The Examiner next treated the claims under the assumption that the claims are not rejected under section 112. Still further, Claims 10 – 12, 15 – 16, and 25 – 26 were rejected under 35 U.S.C. 102(b) as being anticipated by Holland (US 5,105,503). Yet still further, Claims 13 – 14, 17 – 24, and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Holland in view of Haynie (US 6,266,892).

Claims 10 – 19 and 21 – 25 are amended. Claims 28 – 45 are new and find support in paragraphs 24 – 35 and the figures of the application and therefore the Applicant believes there is no new matter.

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Claim Objections

Claims 10 – 19 and 21 – 25 are amended to correct the typographical errors noted in the Office Action.

Claim Rejections – 35 USC § 112

The Office Action noted consideration of “leading” and “trailing” as new matter. The Office Action further noted that while the “original specification discussed a first and second surface wherein the first surface was specified as a leading surface,” the Office Action did not consider “that the introduction of a trailing feature from the specification, can be reasonably conveyed to one skilled in the art that, the original invention, as filed, described that feature.”

As cited in MPEP 2163.07 I, “[m]ere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible.” *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

Further, as cited in MPEP 2163.07(a):

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicitly about it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971).

Applicant notes that the Amendment of 16 February 2005 included an amendment to the specification linking the terms “leading portion” and “trailing portion” to the terms “first surface” and “second surface” respectively. Further, within the same Amendment, the term “leading surface” was linked to the term “forward edge.” The term “trailing

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surface" is present in the drawings, particularly in Figure 6. Further, any differences in the terms "leading" and "trailing" from terms originally used in the application as filed, is present in the drawings and/or inherent in the disclosure. In particular, any difference between the terms is inherently disclosed wherein the direction of use is disclosed in paragraphs 25 and 30 – 34.

The new terms relate to the relationship of the identified portions with respect to a direction of use. The direction of use is disclosed. Therefore, the relationship, while not explicitly disclosed in every instance, is necessarily present and therefore inherent in the original disclosure as filed. Further, the Amendment of 16 February 2005 together with the drawings, clearly identify the new terms to structures present in the original application as filed. For these and other reasons not herein described, the terms "leading" and "trailing" are not new matter.

Claim rejections – 35 USC § 102

Claim 10, upon which all other claims of the present application depend, has been amended to include the limitation "wherein the plurality of channels are configured to be in direct physical communication with the fabric when the device is in operation." The amendment finds support in Figures 5, 6, and 7 and paragraphs 30 – 35 of the specification. In particular, support for the amendment is found in paragraph 32 wherein the pertinent part describes "[t]he channels 120 are preferably formed at the lower end of the first surface 118, such that the channels 120 can be located closer to the fluid at the bottom of the carpeted surface 102." The Applicant believes this description more specifically describes the structural relationship of the plurality of channels to the fabric.

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Holland does not include this limitation. In particular, the grooves, or channels 33 of Holland are not adjacent to a fabric when in operation (see Figures 1, 4, and 9). Further, the channels 33 of Holland are not configured to permit liquid in carpet to pass into the extraction slot 26, but instead to prevent the passage of liquid through the grooves, thereby forcing the liquid into fabric (col. 4 lines 30 – 36). The calibrated grooves are part of a liquid delivery system (col. 3 lines 56 – 59; and col. 4 lines 3 – 5). Therefore, the Applicant believes that Holland does not anticipate the present application as amended.

Claim Rejections – 35 USC § 103(a)

Neither Holland or Haynie disclose the limitation “wherin the plurality of channels are configured to be in direct physical communication with the fabric when the device is in operation” included in the amended Claim 10. Rejected Claims 13 – 14, 17 – 24, and 27 each depend from Claim 10. Therefore, Applicant believes to have overcome the 35 USC § 103(a) rejection of Claims 13 – 14, 17 – 24, and 27.

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Conclusion

For these reasons and others not described herein, it is believed that none of the prior art teaches the claimed invention. Furthermore, it is believed that the foregoing amendment has adequate support in the specification, and accordingly there should be no new matter. Applicant believes the pending claims have addressed each of the issues pointed out by the Examiner in the Office Action. In light of the foregoing amendment, the claims should be in a condition for allowance. Should the Examiner wish to discuss any of the proposed changes, Applicant again invites the Examiner to do so by telephone conference.

Respectfully Submitted,


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